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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,684	03/30/2001	Nobuhito Kozagawa	0397-0425P	8802
2282	7590	02/24/2004	EXAMINER	
GORDON, BRIAN R.				
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ART UNIT	
			PAPER NUMBER	
			1343	

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/820,684

Applicant(s)

KITAGAWA, NOBUHIRO

Examiner

Brian R. Gordon

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any claimed patent term adjustment. See 37 CFR 1.704(d).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 9 and 11 is/are rejected.
- 7) ☒ Claim(s) 2, 3 and 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on March 31, 2000. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).
2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on March 21, 2001. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

### ***Election/Restrictions***

3. Newly submitted claim 10 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 10 is directed to an automatic analyzing apparatus and claims 1-9 and 11 are directed to a dispensing device.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Arguments***

4. Applicant's arguments, see pages 25 and 26 of applicant's remarks, filed November 24, 2003, with respect to the 102(b) rejections based on the disclosures of Kanabara et al. and Iwata et al. have been fully considered and are persuasive. The 102(b) rejections of claims 1-10 have been withdrawn.

***Claim Interpretation***

5. As to claims 1, 4, 5, 9, and 11, the examiner has interpreted the text directed to the description container as language to express the intended use of the dispensing apparatus in conjunction with the container. Applicant's amendment filed November 24, 2003 included an amendment to claim 1, in which the positive recitation of the container was deleted. As such the container is no longer considered as an element of the dispensing device. The container considered as just an element that the dispensing apparatus is intended to be used with in a process. The examiner interprets the device as requiring a container setting part (as claimed); a dispensing mechanism part (as claimed); a raising/lowering part; a base (as claimed with the a projection part); and a base driving part as claimed.

***Specification***

6. The disclosure is objected to because of the following informalities: the specification, as given on page 7, of the reply filed November 24, 2003 at lines 8-14 appears to have a misspelled word: the word "contained" should be changed to -- container--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1, 4, 5, 9, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear what is meant by the phrase "thereby enabling **to act** the pipette and the projection part at a suitable position." It appears as if the phrase "to act" should be changed to better characterize applicant's intent. What is a suitable position? Suitable for what?

The claim is directed to a liquid dispensing apparatus, however it is not clear how any dispensing action occurs.

It appears also as applicant's invention works with the particular structural container as described in the claim, however the container is no longer positively recited as a limitation of the claim, hence it is unclear how the device would work with any other container different from the one described in the claim. It is clear that the device only works in conjunction with the container with the particular structural limitations as described in the specification. As such the container should be recited as a positive limitation of claimed device.

New claim 11 does not further limit the structure of the device of claim 1. Claim 11 is more so a process limitation that recites a step directed to opening the lid of the container (not considered as an element of the device).

#### ***Examiner's Comments***

9. In an effort to expedite the prosecution of the application, the examiner placed a call to Mr. Terrell C. Birch on February 12, 2003. Mr. Birch was not available and a

message was left for him, however Mr. Richard Gallagher returned the call on behalf of Mr. Birch. The examiner informed Mr. Gallagher that the claims would be allowable if approval was given for the examiner to make a few changes to the claims including:

Amending the specification, as given on page 7, of the November 24, 2003 at lines 8-14 so as to change the word "contained" to --container--;

Canceling claim 10;

Amending claims 1 and 6 to be drafted in as:

1. A liquid dispensing apparatus, comprising:

a container for containing a liquid having a lid coupled thereto and adapted to open and close about an opening/closing pivot part, and a hook part that projects upward from the lid when the lid is closed;

a container setting part for setting said container; and

a dispensing mechanism part having a pipette for drawing and dispensing the liquid, a raising/lowering part for raising and lowering the pipette, a base for holding the raising/lowering part and provided with a projection part adapted to engage with the hook part, and a base driving part for moving the base, thereby enabling the pipette and the projection part to move to a suitable operational position for dispensing and aspiration of said liquid,

wherein the base moves horizontally thereby the projection opens the lid by abutting against the hook part and moving the hook part and moves the hook part toward the pivot part side of the container and the pipette is lowered to a position for dispensing a liquid into or aspirating a liquid from said container.

Amend claim 6, by inserting the word "is" in line 2 between the words "part" and "adapted", so as to read, "...wherein the projection part is adapted..."

10. The above claim 1 drafted by the examiner and considered to distinguish patentably over the art of record in this application, was presented to applicant for consideration: Due to the absent of Mr. Gallagher's response to the proposed amendments, another call was placed by the examiner on February 18, 2004 to Mr. Gallagher. Mr. Gallagher informed the examiner that applicant was presented with the suggested amendments but had yet to respond to him. Due to the lack of a response from applicant, this response to applicant's reply is hereby submitted.

***Allowable Subject Matter***

11. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

12. Claims 2-9 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

In particular the claims would be allowable if amended as suggest by examiner as given above.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP


§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700